

REMARKS/ARGUMENTS

The present amendment is submitted in response to the Office Action received from the United States Patent Office dated March 6, 2008. Claims 1-21 are pending in the application. In the Office Action, the Patent Office rejected Claims 7-13 under 35 U.S.C. § 112 as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Patent Office also rejected Claim 2 under 35 U.S.C. § 102(b) as being anticipated by *Caicedo* (U.S. Patent Number 6,145,716). The Patent Office further rejected Claim 8 under 35 U.S.C. § 102(b) as being anticipated by *Syendsen* (U.S. Patent Number 5,964,470). Additionally, the Patent Office rejected Claims 1-3, 5, 16-17, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Tamura* (U.S. Patent Number 6,932,427) in view of *Caicedo*. Moreover, the Patent Office rejected Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Tamura* in view of *Caicedo*, and in further view of *Syendesen*. Finally, the Patent Office rejected Claims 4, 6, 14-15, 18-20 and 7-13 under 35 U.S.C. § 103(a) as being unpatentable over *Tamura* in view of *Caicedo*, and in further view of *Ezquerra* (U.S. Patent Number 3,290,050).

The Patent Office rejected Claims 7-13 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, the Patent Office states that claim 7 recites the limitation “the extensions” in line 1; Claim 8 recites the limitation “the frame” in line 2; and Claim 10 recites the limitation “the extensions” in line 1. The Patent Office asserts that there is insufficient antecedent basis for these limitations in the claims.

In response to the rejection, Claims 7 and 10 have been amended to change “the extensions” to “the grip members,” which have support in their respective previous claims, and in the specification. Claim 8 has also been amended to change “the frame” to “a frame of the stroller backpack.” In light of these amendments, Applicant respectfully submits that the rejections have been overcome. Notice to that effect is requested.

The Patent Office rejected Claim 2 under 35 U.S.C. § 102(b) as being anticipated by *Caicedo*. The Patent Office states that *Caicedo* discloses a collapsible stroller backpack configurable in at least two configurations: a first configuration as a stroller comprising a seat

adapted to receive a child; and a second configuration as a backpack where the seat is no longer adapted to receive a child.

Amended Claim 2 requires a collapsible stroller backpack configurable in at least two configurations. A first configuration is a stroller configuration adapted to transport a child. A second configuration is a backpack configuration. The specification defines “stroller” as “a chair like carriage with three or more wheels for transporting small children.” Additionally, Claim 2 was amended to more particularly point out that stroller be adapted to transport a child.

Caicedo discloses a folding chair and backpack combination device, where an important aspect of the invention is to provide a comfortable, secure and stable seat for a user when opened (*Caicedo*, col. 4, ll. 6-9; col. 4, ll. 59-61). The combination device includes a seatback frame having a crossmember and a pair of supports, where the supports terminate in respective end portions (*Caicedo*, col. 4, ll. 33-35).

However, *Caicedo* does not teach or suggest a stroller configuration as required by Claim 2. Nowhere does *Caicedo* teach a folding chair that is able to move along the ground when opened and thereby able to transport a child. Moreover, the folding chair of *Caicedo* does not include any rollers, wheels, tracks, or sliding surfaces in order to permit the folding chair to easily move across the ground as required by the present invention. Therefore, Application respectfully submits that *Caicedo* does not disclose, teach, or suggest a stroller as required by the invention.

The Patent Office rejected Claim 8 under 35 U.S.C. § 102(b) as being anticipated by *Syendesen*. The Patent Office makes no assertions as to what *Syendesen* discloses or what features of *Syendesen* anticipates Claim 8.

Amended Claim 8 requires a stroller backpack alternately configurable as a stroller and a backpack. More particularly, the stroller backpack includes a handle, and a seat portion of the stroller distinct from a container portion of the backpack. The specification defines “backpack” as “an apparatus comprising a bag or other container that is designed to allow someone to carry articles, not people.” Claim 8 was amended to more particularly distinguish a seat portion for use with the stroller configuration with a separate carrying compartment for use with the backpack configuration, which may be used during the stroller configuration as well.

Syendesen discloses a two-wheeled stroller and a child-supporting backpack. *Syendesen*’s use of a “child supporting backpack” is merely an infant backpack – a backpack adapted for

carrying infants, that may be converted into a stroller. The backpack portion of the *Syendsen* disclosure is a “fabric seat,” where “the fabric seat is for supporting a child during operation and use. The seat includes a rear face. Such rear face is coupled to the bracket. The fabric seat also includes an upwardly extending back and a pair of vertical straps. The vertical straps are parallel and spaced and form the front of the seat.” (*Syendsen*, col. 4, ll. 54-60). *Syendsen* does not disclose a separate compartment for carrying items other than the child; the child seat makes up the only compartment. The “child supporting backpack” is simply a child carrier with shoulder straps.

Syendsen does not teach or suggest a seat portion of the stroller distinct from a container portion of the backpack as required by Claim 8. Nowhere does *Syendsen* disclose a compartment for carrying objects separate from the child carrying compartment.

Under 35 U.S.C. §102(b), anticipation requires that a single reference disclose each and every element of Applicant’s claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986). Moreover, anticipation is not shown even if the differences between the claims and the reference are “insubstantial” and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d. 707, 716, 223 USPQ 1264, 1270 (Fed. Cir. 1984). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (MPEP § 2131).

In view of the foregoing remarks and amendments, the rejection under U.S.C. §102(b) of Claim 2 as being anticipated over *Caicedo*, and Claim 8 as being anticipated over *Syendsen* have been overcome. Notice to that effect is requested.

The Patent Office further rejected Claims 1-3, 5, 16-17, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Tamura* in view of *Caicedo*. The Patent Office states that *Tamura* discloses a collapsible stroller including a stroller configuration adapted to receive a child, a portable backpack configuration where the seat is not adapted to receive a child, and a third configuration where the carrier is used as a suitcase. However, *Tamura* fails to specifically disclose shoulder straps for using the carrier as a backpack. The Patent Office states that *Caicedo* discloses a backpack that contains a seat that can be folded into a use position. The Patent Office further states that it would have been obvious to one having ordinary skill in the art

at the time of the invention to combine the familiar shoulder straps taught by *Caicedo*, with the suitcase structure taught by *Tamura*. Additionally, the Patent Office states that such a combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

Tamura discloses a suitcase with a foldable chair. *Tamura* does not disclose, teach, or suggest a backpack. On the contrary, *Tamura* distinguishes in the specification the suitcase from a portable carrying case, a cloth-made bag with a handgrip, by admitting that the hand-bag is “too small to make the [bag] usable as a suitcase” (*Tamura*, col. 1, ll. 31-35). Similarly, *Tamura* states that the suitcase provides an advantage since it is not “limited to an extremely small amount like the conventional carrying case” (*Tamura*, col. 1, ll. 50-53). The suitcase disclosed by *Tamura* is intended to be used for overseas travel and includes a pair of wheels attached onto the bottom surface (*Tamura*, col. 2, ll. 11, 16-17). More specifically, the suitcase of *Tamura* is not intended to be carried (*see Tamura*, col. 1, ll. 33-35, 50-53; col. 3, ll. 19-25).

Caicedo discloses a folding chair and backpack combination device, where an important aspect of the invention is to provide a comfortable, secure and stable seat for a user when opened (*Caicedo*, col. 4, ll. 6-9; col. 4, ll. 59-61).

Independent Claims 1 and 2 both require “a backpack configuration wherein the stroller backpack is adapted to be worn and to carry items.” Independent claims 1, 2, 16 and 17 all require a “stroller backpack.”

It would not have been obvious to one having ordinary skill in the art at the time of the invention to combine the shoulder straps of *Caicedo* to the suitcase structure of *Tamura*. On the contrary, *Tamura* teaches away from combining these references. *Tamura* asserts that a cart that may be convenient for a hand-baggage conveying means has a capacity too small to make the cart usable as a suitcase. Further, the suitcase of *Tamura* provides a device that permits a larger carrying capacity than provided by the conventional carrying case. Modifying *Tamura* with the shoulder straps of *Caicedo* would render the *Tamura* suitcase unsatisfactory for its intended purpose. The *Tamura* suitcase, if modified with the shoulder straps of *Caicedo*, could not retain its large carrying capacity and convenient roller bag configuration along with the chair structure.

The present invention is alternatively not merely a combination of familiar elements yielding predictable results. *Tamura* does not disclose a backpack as required by independent Claims 1, 2, 16 or 17. The Patent Office correctly stated that *Tamura* “does not teach ... shoulder

straps for [sic] using the carrier as a backpack.” However, the Patent Office improperly suggests that a suitcase is equivalent to a backpack, by stating that the configuration is met by “the seat assembly is folded [sic] out of the way and the carrier is used as a suitcase.” The backpack configuration, however cannot be met by the suitcase of *Tamura*. Putting the shoulder straps of *Caicedo* with the disclosure of *Tamura*, as suggested by the Patent Office, does not result in a backpack. Combining shoulder straps with the *Tamura* suitcase would result in a cumbersome, heavy, bulky, and unusable device for carrying anything on a person’s back. Merely combining the shoulder straps of *Caicedo* with the suitcase of *Tamura* does not result in the present invention.

As enumerated above, neither *Tamura* nor *Caicedo*, taken singly or in combination teach or suggest a stroller backpack as required by Claims 1, 2, 16 and 17.

The Patent Office further rejected Claims 4, 6, 14-15, 18-20, and 7-13 under 35 U.S.C. § 103(a) as being unpatentable over *Tamura* in view of *Caicedo*, as combined above, and in further view of *Ezquerra*. The Patent Office states that the combination of *Tamura* and *Caicedo* does not teach a rotatable handle and grip members. The Patent Office states that these features are provided by *Ezquerra*. The Patent Office states that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of *Tamura* and *Caicedo* with the limitation as taught by *Ezquerra* to allow a handle to be placed at an ergonomic position for a user.

As enumerated above, neither *Tamura*, nor *Caicedo*, taken singly or in combination, disclose, teach, or suggest a stroller backpack as required by Claims 8 and 14. *Ezquerra* does not disclose either a stroller or a backpack, and therefore, cannot provide the missing features.

It is further submitted that the question under § 103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teaching of the reference, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed component's of Applicants' invention. A teaching, suggestion, or incentive must exist to make the combination made by Applicants. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

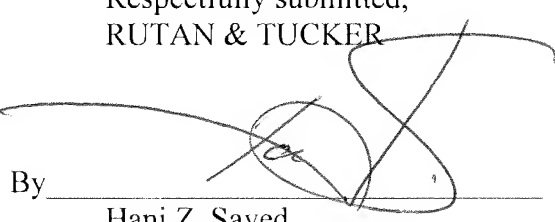
In view of the foregoing remarks and amendments, the rejection of Claims 1, 2, 16, and 17 under 35 U.S.C. § 103(a) as being unpatenetable over *Tamura* in view of *Caicedo* has been overcome. Similarly, the rejection of Claims 8, and 14 under 35 U.S.C. § 103(a) as being unpatenetable over *Tamura* in view of *Caicedo*, and further in view of *Ezquerra* has been overcome. Notice to that effect is requested.

Claims 3-7 depend from Claim 2; Claims 9-13 depend from Claim 8, Claim 15 depends from Claim 14, Claims 18-21 depend from Claim 17. These claims are further believed to be allowable for the same reasons set forth with respect to independent Claims 2, 8, 14, and 17, since each sets forth additional novel elements and steps of Applicant's Collapsible Stroller Backpack.

In view of the foregoing remarks, Applicant respectfully submits all of the claims in the application are in allowable form and that the application is now in condition for allowance. If any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,
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